



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/747,950	12/27/2000	Richard C. Zorn	263-2290	3169

7590 03/15/2004

NIXON & VANDERHYE P.C.
8th Floor
1100 North Glebe Rd.
Arlington, VA 22201-4714

EXAMINER

MYHRE, JAMES W

ART UNIT	PAPER NUMBER
----------	--------------

3622

DATE MAILED: 03/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/747,950

Applicant(s)

ZORN, RICHARD C.

Examiner

James W Myhre

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 December 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Claim 7 is objected to because of the following informalities:

Claim 7 depends upon itself. The Examiner believes this is a typographic error and that Claim 7 should depend upon Claim 6. The Examiner will consider this as the proper dependency in the following Office Action.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 2, 4-6, and 8-11 are rejected under 35 U.S.C. 102(e) as being anticipated by DeBruin-Ashton (6,014,629).

Claims 1, 5 and 9: DeBruin-Ashton discloses a method for targeting promotions to subscribers, comprising:

- a. Creating brochure templates with variable print fields (col 9, line 66 –

col 10, line 67);

b. Accessing a subscriber database and sorting subscribers to create a sub-list of subscribers based on sorting criteria (col 7, lines 1-15 and col 9, lines 24-27).

c. Printing a personalized brochure for each subscriber using the appropriate brochure template (col 13, lines 39-47); and

d. Attaching and sending each of the printed brochures to the appropriate corresponding subscriber (col 13, lines 39-47).

The Examiner notes that DeBruin-Ashton's sorting of the subscribers based on whether or not the subscriber wears eyeglasses is the equivalent of claimed creation of two sub-lists of subscribers.

Claims 2, 6, and 10: DeBruin-Ashton discloses a method for targeting promotions to subscribers as in Claims 1, 5, and 9 above, and further discloses the sorting criteria relates to a characteristic of the subscribers, such as a previous relationship with a particular physician, wearing eyeglasses, living within a certain region, etc. (col 7, lines 1-15 and col 9, lines 24-27).

Claims 4 and 8: DeBruin-Ashton discloses a method for targeting promotions to subscribers as in Claims 1 and 5 above, and further discloses that at least 25% of the brochures include editorial and/or public service information (Figure 3B, items 340).

The Examiner notes that the type of information printed on the brochure does not affect the method steps on customizing the brochure and, thus, is given little if any patentable weight. However, DeBruin-Ashton's lists of health care providers within the vicinity of

the subscribers is considered to be public service information and is shown to cover the majority of the printed page in the brochure.

Claim 11: DeBruin-Ashton discloses a method for targeting promotions to subscribers as in Claim 10 above, and further discloses including a coupon in the printed version of the brochure (Figure 3B, items 346 and col 9, lines 18-27). DeBruin-Ashton further discloses that the coupon is selected and printed based on the personal criteria of the subscriber, i.e. the coupons for a discount on optical services or products shown in Figure 3B are only printed in the brochures being sent to subscribers who wear eyeglasses.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 3 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeBruin-Ashton (6,014,629) in view of Manley et al (5,186,443).

Claims 3 and 7: DeBruin-Ashley discloses a method for targeting promotions to subscribers as in Claims 2 and 6 above, and further discloses that the sorting criteria relates to a characteristic of the subscriber. However, it is not explicitly disclosed that the characteristic relates to the subscriber's fiscal credit. Manley discloses a similar method for sending personalized printed material to subscribers, and further discloses

that the personalization and sorting are based on the subscriber's fiscal credit, i.e. the possession of a particular credit card. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the subscriber's fiscal credit as at least one of the sorting criteria being used by DeBruin-Ashton. One would have been motivated to use this type of criteria in DeBruin-Ashton in order to select physicians which the subscriber can afford, e.g. one who accepts the health insurance held by the subscriber.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Mayer et al (5,287,976) discloses a method for printing and mailing personalized publications.

b. Zorn (6,129,346) and (6,276,724) are the parent patents to the present application.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exr. James W. Myhre whose telephone number is (703) 308-7843. The examiner can normally be reached on weekdays from 6:30 a.m. to 3:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, can be reached on (703) 305-8469. The fax phone number for Formal and Official faxes is (703) 872-9306. Draft or Informal faxes may be submitted directly to the examiner at (703) 746-5544.

Application/Control Number: 09/747,950

Page 6

Art Unit: 3622

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (703) 308-1113.



JWM

March 11, 2004



James W. Myhre
Primary Examiner
Art Unit 3622